

Appln No. 09/801,949
Amdt date October 26, 2004
Reply to Office action of July 28, 2004

REMARKS/ARGUMENTS

Claims 1-52 will be pending in this application upon entry of the above amendments. Claim 52 has been added. The new claim finds support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendments and remarks that follow, reconsideration, reexamination, and an early indication of allowance of the now pending claims 1-52 are respectfully requested.

Amendments to the specification have been made on pages 16, 25, and 29 to correct certain typographical errors in reference and figure numbers. The amendments do not add any new matter. Entry of the amendments to the specification is respectfully requested.

Claims 1, 6, 8-9, 18, 23, 25, 26, 35, 40, and 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Shirley et al. (U.S. Patent No. 5,692,206). Applicant respectfully traverses this rejection.

Independent claims 1, 18, and 35 recite the limitation of "receiving from the requestor via the computer network a document request, the document request including recipient and subject matter information." (Emphasis added). The Examiner contends that Shirley's "document generation method discloses this limitation in that the user selects the type of contract to be generated and enters the names and addresses of the parties to the contract, the term of the contract and relevant financial information." (Office action, p. 3, lines 3-9). However, the information for generating a contract in Shirley's system is not submitted, and therefore not received, via a "computer network" as is recited in claims 1, 18, and 35. In fact, the contract

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generation system disclosed in Shirley is just a personal computer equipped with a program that directly receives from a user, input of data used for generating a contract. The data is input by the user using "input devices, such as the keyboard or the pointing device." (See, Col. lines 50-55). Although Shirley's contract generation system may communicate with other computers via an e-mail unit providing conventional electronic mail functions, and as such, may arguably be deemed to be part of a "computer network," nothing in Shirley teaches or suggests that the e-mail unit is used to receive the information needed for generating the contract. Accordingly, Applicant submits that claims 1, 18, and 35 are in condition for allowance.

Applicant submits that claims 6, 8-9, 23, 25, 26, 40, and 42-43 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations that they contain.

The Examiner rejects claims 2, 4, 19, 21, 36, and 38 under 35 U.S.C. 103(a) as being unpatentable over Shirley in view of Rutten et al. (U.S. Patent No. 6,632,251). Claims 2, 4, 19, 21, 36, and 38 depend directly or indirectly upon an allowable base claim. Accordingly, Applicant submits that claims 2, 4, 19, and 21 are also in condition for allowance.

The Examiner rejects claims 3, 10-17, 20, 27-34, 37 and 44-51 under 35 U.S.C. 103(a) as being unpatentable over Shirley in view of Rutten, and further in view of Kuo (U.S. Patent Pub. No. US 2003/0120615). Applicant respectfully traverses this rejection.

Claims 3, 20, 37, and 44 include the limitation of "creating an approval status document, the approval status document including the status of the approval received for

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generation of a document from a document administrator, the approval status document retrievable via the computer network by the requestor using an approval status document address." Claim 10 includes the limitation of "creating an approval status document, the approval status document including the status of the approval received for generation of a non-disclosure agreement from a non-disclosure agreement administrator, the approval status document retrievable by the marketing representative using an approval status document address." The Examiner acknowledges that Shirley in view of Rutten fails to teach these limitations. However, the Examiner relies on Kuo to make up for this deficiency.

Kuo discloses a process and method for secure online transactions. The buyer transmits an online order and can query the status of financial transactions of the order to a host computer which maintains the status of such financial transactions. As explained by Kuo, the host computer stores the status of a payment authorization request, the status of a payment approval request, and the status of a payment capturing request. (See, par. 72). None of these statuses, however, are statuses of "the approval received for generation of a document from a document administrator." Accordingly, even the combination of Shirley, Rutten, and Kuo fail to teach or suggest all of the limitations of claims 3, 20, 37, and 44.

Even if, *arguendo*, the combination of Shirley, Rutten, and Kuo were to teach all of the limitations of claims 3, 20, 37, and 44, a person of skill in the art would have had no motivation or suggestion to combine the teachings of Kuo to the teachings of Shirley in view of Rutten, because Kuo is nonanalogous prior art. Kuo is directed to a process and method

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for secure online transactions which alleviates online consumer fraud originating from pirated credit card numbers. Applicant's invention, on the other hand, is directed to a system and method for interactively generating and delivering documents via a computer network. Applicant respectfully submits that a person of skill in the art faced with the problem of generating and delivering documents over the network would not turn to art relating to secure online transactions to solve the problem. Applicant therefore submits that claims 3, 20, 37, and 44 are in condition for allowance.

Claims 5, 22, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley. Claims 7, 24, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley in view of Owens et al. (U.S. Patent No. 6,236,984).

Applicant submits that claims 5, 7, 22, 24, 39, and 41 are in condition for allowance because they depend on an allowable base claim, and for the additional limitations that they contain.

Claim 52 is new in this application. Claim 52 includes limitations that are neither taught nor suggested by any of the cited references. Applicant therefore respectfully submits that claim 52 is in condition for allowance.

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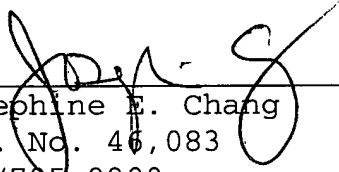
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In view of the above amendments and remarks, Applicant respectfully requests reconsideration, reexamination, and an early indication of allowance of the now pending claims 1-52.

Respectfully submitted,

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